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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,050	03/11/2004	Bradley C. Ashmore	14405-08545	8591
758	7590	11/14/2006	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			TRINH, SONNY	
			ART UNIT	PAPER NUMBER
			2618	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/800,050		ASHMORE ET AL.	
	Examiner		Art Unit	
	Sonny TRINH		2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 19-35, 37-51, 53 is/are rejected.
- 7) ☒ Claim(s) 19, 36 and 52 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objection

1. **Claim 49** is objected to because of the following informalities: Claim 49 relates to computer program which cannot depend on claim 28 (method claim). For the purpose of examining, it is assumed that claim 49 depends on claim 38. Appropriate correction is required.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. **Claims 1, 21 and 38** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,738,630. Although the conflicting claims are not identical, they are not patentably distinct from

each other because claims 1, 21 and 38 of the current Application and claims 1, 21 and 41 (respectively) of Patent Number 6,738,630 claim the same subject matter with wording variations only.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-10, 13-18, 20-28, 31-35, 37-45, 48-51, 53** are rejected under 35 U.S.C. 102(e) as being anticipated by Tijerino (U.S. Patent Number 6,405,034 B1).

Regarding **claim 1**, with reference to figures 1-2 and descriptions, Tijerino discloses a method for providing content to a mobile device, comprising: receiving from the mobile device data representative of a marker (such as the user is presented with his choice of services (block 210-230 of figure 2), column 2 lines 26-44); receiving data representative of a context for the marker (such as ATM location, banks, gas station etc...(column 3 lines 30-54); analyzing the data representative of the context for the marker to determine a domain for the marker (such as the environment data (e.g. position of the user) column 4 lines 27-42); determining content responsive to the marker and the domain for the marker, wherein the marker maps to specific content for

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the domain; and providing the determined content to the mobile device (column 4 lines 27-65).

Regarding **claim 2**, since the system provides the user with his choice of communication such as the selection of a gas station for example as discussed above, it is inherent that the data representative of the context for the marker indicate a particular cell in a cellular telephone system.

Regarding **claim 3**, Tijerino further discloses that the data representative of the marker and the data representative of the context for the marker are received from a mobile network support system in communication with the mobile device (column 4 line 66 to column 5 line 10).

Regarding **claims 4-7**, since Tijerino discloses that the user can select his choice of communication such as selecting an ATM, banks etc. (see column 3 lines 30-54) and the system will provide the information depending on the location of the user (column 4 lines 28-42). Therefore it is inherent that the marker or markers maps/map to content in a plurality of domains or a plurality of domains.

Regarding **claim 8**, Tijerino further discloses the steps of: receiving, by the mobile network support system from the mobile device, the data representative of the marker; and accessing a context server in communication with the mobile network support system to determine the data representative of the context for the marker (column 4 line 66 to column 6 line 4).

Regarding **claim 9**, Tijerino further discloses the steps of determining content responsive to the marker and the domain for the marker comprises the step of:

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accessing a content database holding content associated with a plurality of markers for a plurality of domains, wherein the database includes mappings describing specific content associated with specific markers for specific domains (column 4 line 66 to column 6 line 4).

Regarding **claim 10**, Tijerino further discloses the analyzing step comprises the step of: correlating data received via a data feed with the data representative of a context for the marker to determine a domain for the marker (column 5 line 51 to column 7 line 20).

Regarding **claim 13**, Tijerino further discloses that the marker is visibly displayed on a physical object (column 3 lines 30-54).

Regarding **claim 14**, Tijerino further discloses that the analyzing occurs after receipt of the data representative of the marker from the mobile device (see figure 2 and description).

Regarding **claim 15**, Tijerino further discloses that the analyzing step comprises the step of: selecting a domain for the marker from among a plurality of possible domains for the marker (column 3 lines 30-54).

Regarding **claims 16-18**, Tijerino further discloses that the analyzing step explicitly determines the domain and performing a database lookup using the data representative of the context to determine the domain for the marker (figure 2 and description).

Regarding **claim 20**, Tijerino further discloses that the data representative of the context for the marker includes a plurality of variables indicating the context and

wherein the analyzing step comprises: determining a domain for the marker responsive to the plurality of variables included in the data representative of the context (figure 2, please see description).

Claims 21-23 specify the system necessary for performing the method claim of claims 1-3 and are therefore rejected for the same reasons.

Claim 24 specify the system necessary for performing the method claim of claim 8 and is therefore rejected for the same reasons.

Claims 25-28, 31-35, 37 specify the system necessary for performing the method claim of claims 4-7, 13, 15-18, 20 (respectively) and are therefore rejected for the same reasons.

Claims 38-45, 48-51, and 53 specify the computer program necessary for performing the method claim of claims 1-3, 8, 4-7, 13, 16-18, and 20 (respectively) and are therefore rejected for the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 11-12, 29-30, 46-47** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tijerino.

Regarding **claims 11-12**, since these 2 claims specify the opposite limitations such as the marker does not have an intrinsic meaning related to the determined content and the marker has an intrinsic meaning related to the determined content. The limitations of claims 11 and 12 therefore are not critical to the function(s) of the invention and are obvious to a person of ordinary skill in the art.

Claims 29-30 specify the system necessary for performing the method claim of claims 11-12 and are therefore rejected for the same reasons.

Claims 46-47 specify the computer program necessary for performing the method claim of claims 11-12 and are therefore rejected for the same reasons.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claim 38** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 38 is drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a

data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. Similarly, computer programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized.

Allowable Subject Matter

6. **Claims 19, 36** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 19** the applied references fail to disclose or render obvious the claimed limitations specifically wherein the analyzing step of claim 1 comprises: establishing data representative of domain information describing possible domains for

the marker; establishing business logic describing relationships among the data representative of the context for the marker and the data representative of domain information; analyzing the business logic, the data representative of the context for the marker, and the data representative of domain information to determine the domain for the marker.

Regarding **claim 36**, the applied references fail to disclose or render obvious the claimed limitations specifically wherein the content server comprises: a domain database holding domain information describing possible domains for the marker; and a domain mapping module in communication with the domain database and adapted to analyze business logic establishing relationships among the data representative of the context for the marker and the domain information to determine the domain for the marker.

7. **Claim 52** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and must overcome the 101 rejection indicated above.

Regarding **claim 52**, the applied references fail to disclose or render obvious the claimed limitations specifically wherein the the domain mapping module interfaces with a domain database holding domain information describing possible domains for the marker and wherein the domain mapping module is adapted to analyze business logic establishing a relationship between the data representative of the context for the marker and the domain information to determine the domain for the marker.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 571-272-7927. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward URBAN can be reached on 571-272-7899. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

11/8/06


SONNY TRINH
PRIMARY EXAMINER